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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/779,943

02/17/2004

Nobuyuki Tatsumi

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EXAMINER

RAMDHANIE, BOBBY

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

01/09/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	10/779,943		TATSUMI, NOBUYUKI	
	Examiner		Art Unit	
	BOBBY RAMDHANIE		1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Allowable Subject Matter

1. The indicated allowability of claims 3-6 are withdrawn in view of the newly discovered reference(s) to Nobuyuki (JP09-127078). Applicant has submitted this reference in IDS dated: 08/02/2007. Rejections based on the newly cited reference(s) follow.

Response to Arguments

2. Applicant's arguments, see Remarks, filed 11/05/2008, with respect to the rejections under 112 have been fully considered and are persuasive. The rejections of 112 have been withdrawn.

3. Applicant's arguments with respect to claims 1 & 3-6 have been considered but are moot in view of the new ground(s) of rejection. The new grounds of rejection are necessitated by Applicant's amendments to the Claims in which a pump or "exchanging mechanism" has been added.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1 & 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimadzu's AOC-17 Auto Injector or AOC-20 series Automatic Sampling System in view of Nobuyuki (JP09-127078).

7. Applicant's claims are toward a device and method.

8. Regarding Claims 1 & 5, Shimadzu's AOC-17 and AOC-20, discloses the automatic sampler and method, comprising: A). A needle adapted to draw a sample from a sample liquid bath and to inject the sample into a sample introducing portion which is in fluid communication with a column of a liquid chromatography (See Sample injection method, both require a syringe which has a needle); B). A first rinsing bath adapted to contain a first rinsing liquid (See Solvent Flush Injection mode & Injection), a receptacle is needed to hold the rinsing solution); C). A second rinsing bath adapted to contain at least one kind of second rinsing liquid (See Solvent Flush Injection mode & Injection); and E). A controller, configured to execute at least one of a first rinsing operation which soaks the needle in the first rinsing liquid in the first rinsing bath, and a second rinsing operation which soaks the needle in the second rinsing liquid in the second rinsing bath and exchanges the second rinsing liquid while the needle is kept

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inserted into the second rinsing bath (see PC which has the appropriate software and the needle must be within the bath itself for some duration of time to obtain the sample, which essentially allows for soaking). Shimadzu's AOC-17 and AOC-20 do not disclose D) an exchanging mechanism operable to exchange the second rinsing liquid in the second rinsing bath. Nobuyuki discloses the automatic sampler, comprising: A). A needle adapted to draw a sample from a sample liquid bath and to inject the sample into a sample introducing portion which is in fluid communication with a column of a liquid chromatography (See Drawing 1 Item 17 a needle); B). A rinsing bath adapted to contain a rinsing liquid (See Drawing 1 Item 20 which contains a rinsing solvent and D). An exchanging mechanism operable to exchange the rinsing liquid in the rinsing bath (See Drawing 1 Item 11 – which is a syringe which is used as a pump to pump fluid into the rinsing bath). It would have been obvious to one of ordinary skill in the art at the time the invention was made (note: both prior art references are from the same assignee) to modify the automatic sampler of the AOC-17 and the AOC-20 with sampler of Nobuyuki and a second or a plurality of rinsing baths and exchanging mechanisms since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192, and since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

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9. For Claim 3, the combination of Shimadzu's AOC-17 and AOC-20 and Nobuyuki discloses the method for rinsing a needle of an automatic sampler, said method comprising: A). Providing a first rinsing bath containing a first rinsing liquid; B). Providing a second rinsing bath containing a second rinsing liquid;, and a second rinsing operation in which the needle is soaked in the second rinsing liquid in the second rinsing bath and the second rinsing liquid is exchanged while the needle is kept inserted into the second rinsing bath; and D). Executing the at least one of the first rinsing operation and the second rinsing operation selected by the operator (See Rejections above to Claims 1 & 5). The combination does not explicitly disclose C) causing an operator to select at least one of a first rinsing operation in which the needle is soaked in the first rinsing liquid in the first rinsing bath. The combination does however disclose that multiple samples made be used with each sampler. It would have been obvious to one of ordinary skill in the art at the time the invention was made to cause an operator to select at least one of a first rinsing operation in which the needle is soaked in the first rinsing liquid in the first rinsing bath because the references all disclose using the same needle for multiple samples, which invariably would cause an operator to use one rinsing liquid bath over another depending on the samples injected (either aqueous or organic).

10. For Claim 4, the combination of AOC-17 and AOC-20 and Nobuyuki disclose the method for rinsing a needle of an automatic sampler according to claim 3, further comprising: selecting one of plural kinds of liquid as the second rinsing liquid to be supplied to the second rinsing bath to exchange the second rinsing liquid in the second

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rinsing bath (See Rejection of Claim 3 above, this would be essential depending on the type of sample use - aqueous or organic sample).

11. Regarding Claim 6, the combination of AOC-17 or AOC-20 with Nobuyuki discloses the automatic sampler according to claim 5, except for further comprising: a switcher, configured to select one of plural kinds of liquid as the second rinsing liquid supplied to the second rinsing bath. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the autosampler to include a switcher to configured to select one of plural kinds of liquid as the second rinsing liquid supplied to the second rinsing bath because switchers (Examiner takes the position that 3, 4, 6, 8-port valves are included in this term) are commonly found in liquid chromatography instruments for selecting different solvents and solvent systems in FPLCs, HPLCs, and ESI-MS instruments depending on the samples being investigated.

Telephonic Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BOBBY RAMDHANIE whose telephone number is (571)270-3240. The examiner can normally be reached on Mon-Fri 8-5 (Alt Fri off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Griffin can be reached on 571-272-1447. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. R./

/Walter D. Griffin/
Supervisory Patent Examiner, Art Unit 1797